REMARKS

Claims 1, 3, 4, 8, 9, 11, 12 and 16-19 were amended. Claims 2 and 10 are canceled without prejudice. New claims 21-24 are added. The amendments and new claims are supported by the application as filed and do not present new matter. (See, e.g., original claims 2 and 10; p. 1, line 10 - p. 2, line 3; p. 5, lines 21-22 (describing identification of cells and cellular analysis). Claims 1, 3-9 and 11-24 are currently pending in the application. Reconsideration of the application, as amended, is respectfully requested.

I. Independent Claims 1 and 18 Are Novel Over Abrams

Independent claims 1 and 18 are rejected under 35 U.S.C. §102(b) as being anticipated by International Publication Number WO 02/21425 to Abrams ("Abrams"). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference MPEP § 2131 (emphasis added); *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306 (Fed. Cir. 2003). "The identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Applicants respectfully traverse the rejection. In order to expedite prosecution of the application, Applicants offer the following remarks.

Applicants respectfully submit that Abrams does not disclose "a cytological specimen carrier" and "wherein data related to cellular analysis of a cytological specimen carried in or on the carrier may be stored in, and retrieved from, the data storage device" as recited in claim 1. Further, Applicants respectfully submit that Abrams does not disclose or suggest "providing a cytological specimen" and "storing data related to cellular analysis of the cytological specimen.." as recited in claim 18.

For the Examiner's reference, Applicants note that "cytological" is defined as "of or relating to the science of cytology" and that "cytology" is defined as "the branch of biology that deals with the formation, structure and function of cells." (www.dictionary.com). These definitions are consistent with the use of "cytological" in the subject application, and the related data that is obtained from analyzing cells or groups of cells of cytological specimens. (See, e.g., original claims 2 and 10; p. 1, line 10 - p. 2, line 3; p. 5, lines 21-22 (describing identification of cells and cellular analysis)).

Abrams, on the other hand, describes a method for ensuring the integrity and chain of custody of a specimen for use in the dairy and drug testing industries. (Abrams, Abstract; page 1, lines 23-24; page 1, line 26 - page 2, line 1; page 2, lines 8-10). For example, Abrams describes integrity and chain of custody of milk samples using the date, unique identification, specific dairy, specific dairy tank, time, date, temperature information in the dairy industry. (Abrams, p. 3, lines 1-16). Abrams also describes integrity and chain of custody of blood and urine samples using date, unique vial identification, individual's identification, time, date and office information in the drug testing industry. (Abrams, p. 4, lines 2-19). Besides describing dairy and drug testing applications, Abrams explains that it is known to use RFID devices to "identify individuals, packages, inventory and the like." (Abrams, p. 1, line 25; p. 2, line 10).

Abrams is understandably silent as to cytological analysis and as to data that is related to a cellular analysis of a cytological specimen in view of the identification and chain of custody data described by Abrams. Arams describes identification, integrity and chain of custody of the specimen on a "macro" level rather than data of cellular analysis or "micro" level. For example, Abrams relates to ensuring that "Specimen No. 1" is from "Person A," rather than analyzing portions of cytological specimens to determine whether or not a cell or group of cells may be malignant.

Correspondingly, Applicants respectfully request that the rejection of independent claims 1 and 18 under 35 U.S.C. §102(b) be withdrawn considering the deficiencies of Abrams.

II. Dependent Claims 4, 5, 8 and 20 Are Novel Over Abrams

Dependent claims 4, 5, 8 and 20 are rejected under 35 U.S.C. §102(b) as being anticipated by Abrams. Claims 4, 5, 8 and 20 add novel and non-obvious limitations to respective independent claims 1 and 18 and incorporate the elements and limitations of respective independent claims 1 and 18. Accordingly, Applicants respectfully request that the rejection of claims dependent claims 4, 5, 8 and 20 under 35 U.S.C. §102(b) be withdrawn based on the above remarks.

III. Dependent Claims 3, 6 and 7 Are Patentable Over Abrams and Weissman.

Dependent claims 3, 6 and 7 are rejected under 35 U.S.C. §103(a) as unpatentable over Abrams in view of U.S. Patent No. 5,561,556 to Weissman ("Weissman"). The Office action relies on Weissman as disclosing a slide, a magnetic storage device and an optical storage device (Office action, p. 3).

Under 35 U.S.C. §103(a), to establish a *prima facie* case of obviousness of a claim, all the claim limitations must be taught or suggested by the prior art, and all words in a claim must be considered in judging the patentability of that claim against the prior art. MPEP §§2143; 2143.03; *In re Royka*, 490 F.2d 981 (CCPA 1974). Moreover, there must be some suggestion or motivation to modify the reference, and a reasonable expectation of success. MPEP §§2143.01-2143.03; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01; *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Applicants respectfully submit that there is no suggestion or motivation to combine the references.

Weissman relates to microscope slides having a pathology specimen and describes a system for analyzing the specimen. (Weissman, Abstract; col. 1, lines 24-31, 51-54). Abrams, on the other hand, relates to ensuring the integrity and chain of custody of a specimen in the dairy and drug testing industries. (Abrams, p. 2, lines 1-12; p. 4, lines 1-16). Abrams does not disclose or suggest, and is not related to, pathology applications and the related examination of specimens.

In other words, Abrams relates to properly identifying and tracking of samples, e.g., whether "Specimen No. 1 is from "Person A" and does not involve examination and analysis of cytological specimens on a cellular level. Accordingly, there is no suggestion or motivation to combine Abrams and Weissman considering these different applications and analyses, and further considering that such additional "cytological" analysis data is not needed in the system described in Abrams since the "chain of custody" objectives described by Abrams can be achieved without this information. Accordingly, Applicants respectfully submit that the required suggestion or motivation to combine the cited references is lacking.

Moreover, Applicants respectfully submit that dependent claim 3 is not obvious over Abrams in view of Weissman since the asserted combination would render Abrams unsatisfactory for its intended purpose. Further, Abrams teaches away from the asserted combination. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.); MPEP §2143.01 (*In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Moreover, it is improper to combine references where the references teach away from their combination. MPEP §2146; *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983).

Abrams is specifically concerned with "maintaining, tracking and identifying the integrity of a specimen container using a disposable specimen container." (Abrams, p. 2, lines 15-16). Further describing these objectives, Abrams explains that it is "important to ensure the so-called 'guaranteed chain of custody' of the container contents by providing a 'tamper evident' seal to the vial - to protect from being opened by unauthorized personnel who might tamper with the contents." (Abrams, p. 2, lines 9-12). In this regard, Abrams explains "the present invention may be used with a variety of bodies including bottles, vials, spouts or any other containers." (Abrams, p. 5, lines 4-7).

Applicants note that all of the containers described by Abrams (p. 5, lines 4-7) are closable and/or sealable. This is consistent with Abrams' explanation of seeking to prevent tampering with the specimen inside the container. Replacing the vial and other closeable / sealable containers with a slide, as asserted in the Office action, would expose the sample to the environment, and the sample would be readily accessible to anyone, including unauthorized persons who may tamper with the sample, thereby allowing the integrity of the specimen to be destroyed. Thus, the asserted combination renders Abrams unsatisfactory for its intended purpose, and Abrams teaches away from such a combination.

Accordingly, the rejection of dependent claim 3 under 35 U.S.C. §103(a) cannot stand. Applicants respectfully request that the rejection of dependent claims 3, 6 and 7 under 35 U.S.C. §103(a) be withdrawn in view of the forgoing remarks.

IV. Independent Claim 9 Is Patentable Over Abrams, Weissman and Ellis

Independent claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams, as modified by Weissman, and further in view of U.S. Patent No. 6,631,203 to Ellis ("Ellis"). The Office action relies on Ellis as disclosing a camera and an imaging processor for analyzing images of the specimen.

Ellis relates to automated analysis of images of a specimen cells on a microscope slide. (See, e.g., Ellis, col. 7, line 65 - col. 8, line 3). This involves automatically scanning samples, processing the data to obtain images, and automatically detecting a target of interest of the specimen. (See, e.g., Ellis, claim 1). As discussed above, Abrams is not related to analyzing cells, much less scanning specimens, processing data to prepare images of sections of specimens, and analyzing sections of the specimens. Rather, Abrams describes a method related to ensuring the integrity and chain of custody of a specimen for use in the dairy and drug industries. (Abrams, Abstract; page 1, lines 23-24; page

1, line 26 - page 2, line 1; page 2, lines 8-10). In other words, Abrams relates to ensuring that "Specimen No. 1" is from "Person A." Abrams describes integrity and chain of custody of milk samples using the date, unique identification, specific dairy, specific dairy tank, time, date, temperature information in the dairy industry. (Abrams, p. 3, lines 1-16). Similar information is used to ensure integrity and chain of custody of blood and urine samples for drug testing. (Abrams, p. 4, lines 2-19). Therefore, the required suggestion or motivation to combine Abrams with Weissman and to combine Abrams with both Weissman and Ellis is lacking in view of the different objectives and different data to achieve those objectives described by the asserted references. Thus, Applicants respectfully request that the rejection of independent claim 9 under 35 U.S.C. §103(a) be withdrawn.

V. Dependent Claims 11-17 Are Patentable Over Abrams, Weissman and Ellis

Dependent claims 11-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Abrams, Weissman and Ellis. Claims 11-17 add novel and non-obvious limitations to independent claim 9 and incorporate the elements and limitations of claim 9.

Moreover, Applicants respectfully submit that dependent claim 11 is non-obvious over Abrams in view of Weissman and Ellis since the asserted combination would render Abrams unsatisfactory for its intended purpose, and Abrams teaches away from the asserted combination. As discussed above, Abrams is directed to "maintaining, tracking and identifying the integrity of a specimen container using a disposable specimen container" and that it is "important to ensure the so-called 'guaranteed chain of custody' of the container contents by providing a 'tamper evident' seal to the vial - to protect from being opened by unauthorized personnel who might tamper with the contents." (Abrams, p. 2, lines 9-16). In this regard, Abrams further explains that "the present invention may be used with a variety of bodies including bottles, vials, spouts or any other containers." (Abrams, p. 5, lines 4-7).

The containers described by Abrams are all closable and/or sealable in order to prevent tampering with the container contents. Replacing the vial and other closeable / sealable containers with a slide, as asserted in the Office action would result in a dairy or drug testing sample being exposed to the environment and readily accessible to anyone, including unauthorized persons who may tamper with the sample, thereby destroying the integrity of the specimen. Thus, the asserted

combination renders Abrams unsatisfactory for its intended purpose, and Abrams teaches away from such a combination. Accordingly, the rejection of dependent claim 11 cannot stand.

Applicants respectfully request that the rejection of dependent claims 11-17 under 35 U.S.C. §103(a) be withdrawn in view of the forgoing remarks.

VII. New Claims 21-24 Are Patentable Over Abrams, Weissman and Ellis

Dependent claims 21-24 add novel and non-obvious limitations to respective independent claims 1, 9 and 18 and incorporate the elements and limitations of respective independent claims 1, 9 and 18.

Claim 21 recites "wherein the data related to the analysis of the specimen is cellular analysis data." Abrams does not involve cellular analysis, as discussed above. Claims 22-24 include limitations related to "a coordinate of a field of interest or a coordinate of a marked target zone." Abrams does not disclose or suggest these limitations, and such information is not needed for the "chain of custody" objective described in Abrams. Further, there is no suggestion or motivation to make the asserted combinations with Abrams, as discussed above.

VIII. Conclusion

In view of these amendments, Applicants respectfully request that application is in condition for allowance. If there are any remaining issues that can be resolved by telephone, Applicants invite the Examiner to contact the undersigned at the number indicated below.

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